## REMARKS/ARGUMENTS

Claims 1-19 are currently pending in the application. Claims 1-19 were initially rejected in the Office Action under 35 USC §103 as being unpatentable over Torres (U.S. Pat. 5,384,910) in view of Le Blanc (U.S. Pat. 5,977,968) and further in view of the Background section of the instant application.

Section 103 Issues

In rejecting the claims, the office action cited the applicant's Background section at page 1, lines 10-16. The Background section at pages 10-16 reads as follows:

> "In the past, graphical user interfaces (GUI's) have been supplied as part of computer programs to facilitate the interaction between the user of a program and the program itself. For example, a typical audio player GUI allows a user to interface with the application program. The audio program provides a basic GUI that the user can use as a dialog box to direct the program on how to perform its functions, e.g., play, fast forward, change tracks, etc. A dialog is essentially an interface that allows the user to communicate with the program, e.g., the common dialog boxes of Microsoft Windows 98."

The office action states that this portion of the applicant's specification was cited for the proposition that it teaches the element of "**without supplying an input to said application program controlled by said graphical user interface.**" The complete element of the claim from which this quote is taken reads:

**"providing a control accessible by said user wherein said control is operable by said user to independently reconfigure the shape of said subsection of said graphical**

**user interface in a plurality of user desired configurations in response to operation of said control by said user without supplying an input to said application program controlled by said graphical user interface."**

It is respectfully noted that the Background section cited by the examiner does not stand for the proposition for which the examiner cited it. Namely, the cited portion of the specification does not teach any reconfiguration of a graphical user interface. As can be seen above, the first sentence in the quoted passage from the Background notes that interaction can take place between the user of the program and the program itself. The second sentence notes that a GUI allows a user to interface with an application program. The third sentence indicates that the GUI can be used to direct the application on how to perform its functions. And, the fourth sentence indicates that a dialog box is essentially an interface that allows a user to communicate with the program. None of these sentences teaches reconfiguring a graphical user interface without supplying an input to the application program controlled by the graphical user interface -- in fact these sentences don't even teach reconfiguring a graphical user interface by supplying an input to the application program.

Since the office action notes in section 3, second paragraph that neither the Torres nor the LeBlanc references teach the aspect of "**without supplying an input to said application program controlled by said graphical user interface**" and since the Background section cited by the examiner also does not teach this, as explained above, the rejection of claim 1 is respectfully traversed. Since the office action relied on the reasons and rationale used in rejecting claim 1 in order to reject claims 2-3, and 11, the rejection of claims 2-3 and 11 is also traversed under the same rationale as explained above for claim 1. Claim 4-10 and 12 are dependent upon claim 2. Therefore, they are allowable for the same reasons that claim 2 is allowable. Claims 14-18 were rejected for the same reasons and rationale used in rejecting claim 2. Therfore, claims 14-18 are believed to be allowable for the same reasons that claim 2 is allowable. Finally, the office action stated that claim 19 was rejected for the same reasons as claim 2. Thus, claim 19 is also believed to be allowable for the same reasons that claim 2 is allowable.

Motivation to Combine Issues

The office action combines three sources in order to reject the claims: (1) discussion from the Background section of the application; (2) the Torres reference; and (3) the Le Blanc reference. To reject claims under 35 USC §103, an examiner must provide a motivation from the prior art to combine the sources being used to make the rejection. The office action appears to recite the motivation to combine these sources as being due to the combination of the sources facilitating the interaction between the user of a program and the program itself. This motivation does not appear to come from the prior art. Rather, it appears to come from the applicant's own invention. As the MPEP (original eighth edition, August 2001, revision 1, February 2003) notes in section 2143.01 at the bottom of page 2100-126, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (citing In re Mills, 916 F. 2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). The MPEP goes on to say "Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so' " (citing In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992))[1]. Since the prior art references did not suggest the desirability of the combination, applicant respectfully traverses the combination of the references to reject the claims.

## CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

[1] The Federal Circuit also has noted that the general skill in the art will rarely operate to supply missing knowledge or prior art to reach an obviousness judgement. As stated by the Federal Circuit:
"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." See W.L. Gore and Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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